

Remarks

Amendments to the Claims

Claims 23 and 25 have been cancelled without prejudice.

Claims 14, 16, 21 and 24 have been amended as indicated above.

In particular, claim 14 has been amended to correct an antecedent basis issue regarding the phrase "the print job", and claims 14 and 16 have been respectively amended to expand on (i.e., define) the abbreviation "PML", so to address rejection of those claims under 35 U.S.C. § 112, second paragraph. Support for the amendments to claims 14 and 16 with respect to the abbreviation "PML" can be found at least on page 5, lines 4-7 of the Specification as originally filed.

Claim 21 has been amended to include limitations directed to a message formatted as a print job and including the PML object UI\_SELECT\_OPTION. Support for the amendment to claim 21 can be found at least on page 2, line 10 to page 5, line 29 of the Specification as originally filed. Claim 24 has been amended to depend from claim 21 (as amended). No new matter has been introduced by the amendments to the claims.

Rejection of Claims under 35 U.S.C. § 112

Claims 14-20 and 25 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, the Examiner has asserted that:

- 1) The term "the print job" as used in claim 14 is lacking proper antecedent basis; and
- 2) The abbreviation "PML" as used in claims 14, 16 and 25 is uncertain and should be expanded upon.

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1 In regard to the § 112 rejection of claim 25, that claim has been cancelled as  
2 indicated above. Therefore, the § 112 rejection of claim 25 is now moot. In regard  
3 to claims 14 and 16, those claims have been respectively amended as indicated  
4 above to address the Examiner's grounds for § 112 rejection. As a result, the  
5 Applicants respectfully request that the § 112, second paragraph, rejection of claims  
6 14-20, as respectively amended, be withdrawn.

7  
8 Rejection of Claims under 35 U.S.C. § 103

9 Claims 21-24, 27, 29 and 31-32 stand rejected under 35 U.S.C. § 103(a) as  
10 being unpatentable over U.S. Patent No. 5,898,823 ("Sorkin"), in view of U.S. Patent  
11 No. 6,728,012 ("Bacher"). Claim 28 stands rejected under 35 U.S.C. § 103(a) as  
12 being unpatentable over Sorkin and Bacher, in view of "Official Notice". Claims 14,  
13 16 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over  
14 Sorkin and Laser Jet Series 4050 Printer Model Specific MIB, in view of "Official  
15 Notice". Claims 26 and 30 stand rejected under 35 U.S.C. § 103(a) as being  
16 unpatentable over Sorkin and Bacher, in view of U.S. Patent No. 6,219,151  
17 ("Manglapus"). Claims 15, 19 and 20 stand rejected under 35 U.S.C. § 103(a) as  
18 being unpatentable over Sorkin and Laser Jet Series 4050 Printer Model Specific  
19 MIB, in view of "Official Notice as applied to claims 14 and 16, and in further view of  
20 Bacher. Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable  
21 over Sorkin and Laser Jet Series 4050 Printer Model Specific MIB, in view of "Official  
22 Notice" as applied to claims 14 and 16 above, and in further view of Manglapus.  
23 Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over  
24 Sorkin, Bacher and Laser Jet Series 4050 Printer Model Specific MIB, in view of  
25 "Official Notice".

Claims 23 and 25 have been cancelled as indicated above. Thus, the  
respective § 103 rejections of claims 23 and 25 are now moot.

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1 Claim 15 depends from claim 14, as amended. Claims 17-20 depend, directly  
2 or indirectly, from claim 16, as amended. Claims 22, 24 and 26-32, as respectively  
3 amended, depend from claim 21, as amended. It is axiomatic that any claim  
4 depending (directly or indirectly) from an allowable base claim is also allowable. For  
5 this reason, the Applicants focus the following arguments in favor of allowability on  
6 independent claims 14, 16 and 21, as respectively amended. The Applicants do not  
7 believe it necessary to present arguments in favor of each and every dependent  
8 claim in order to demonstrate their respective allowabilities.

9 As a starting point, MPEP 706.02(j) states:

10 "[t]o establish a *prima facie* case of obviousness, three basic  
11 criteria must be met. First, there must be some suggestion or  
12 motivation, either in the cited references themselves or in the  
13 knowledge generally available to one of ordinary skill in the art, to  
14 modify the reference or to combine the reference teachings. Second,  
15 there must be a reasonable expectation of success. Finally, **the prior**  
16 **art reference (or references when combined) must teach or**  
17 **suggest all the claim limitations.** The teaching or suggestion to  
18 make the claimed combination and the reasonable expectation of  
19 success must both be found in the prior art and not based on  
20 applicant's disclosure." (Emphasis added.)

## 21 22 Claim 14

23 The Applicants assert that claim 14, as amended, and claim 15 that depends  
24 therefrom, are allowable. In regard to claim 14, as amended, the claim recites the  
25 following features and limitations:

A method for a client to discover a peripheral address, by way of  
a peripheral server, the method comprising:

1            sending a first message to the peripheral server, wherein the  
2            first message contains an address of the client, and wherein the first  
3            message is formatted as a print job that contains a Peripheral  
4            Management Language (PML) object, and wherein the PML object is  
5            UI\_SELECT\_OPTION, and wherein the print job includes no content  
6            resulting in a printed output; and

7            receiving at the client a second message containing the  
8            peripheral address.

9            (Emphasis added).

10  
11           Sorkin fails to teach or suggest sending a first message to the peripheral  
12           server, wherein the first message contains an address of the client, and wherein the  
13           first message is formatted as a print job that contains a Peripheral Management  
14           Language (PML) object, and wherein the PML object is UI\_SELECT\_OPTION, as  
15           recited in combination with the other feature and limitations of claim 14, as  
16           amended. In fact, the Examiner has admitted that Sorkin is specifically lacking the  
17           PML object UI\_SELECT\_OPTION, or any suggestion or teaching directed thereto  
18           (page 8 of Office Action).

19           Sorkin is directed to establishing direct communication between a client  
20           computer 14 and a networked printer 24 by way of *SNMP traps* (Col. 2, lines 3-50 of  
21           Sorkin). Sorkin fails to teach or suggest, in any context, the use of *any* PML object,  
22           and Sorkin completely fails to teach or suggest use of the specific PML object  
23           UI\_SELECT\_OPTION.

24           The Laser Jet Series 4050 Printer Model Specific MIB (hereinafter, the 4050  
25           MIB) fails to cure the deficiency of Sorkin. Specifically, the 4050 MIB fails to teach  
         or suggest the particular PML object UI\_SELECT\_OPTION, as recited in  
         combination with the other features and limitations of claim 14, as amended. The

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1 Examiner has acknowledged this deficiency on the part of the 4050 MIB (page 9 of  
2 Office Action). However, the Examiner states at Para. 27 of the Office action:

3       "Although, The Laser Jet Series 4050 Printer Model Specific  
4 MIB taught wherein the PML object is HELD\_JOB\_DELETE, however,  
5 Sorkin and The Laser Jet Series 4050 Printer Model Specific MIB did  
6 not specifically teach wherein the PML object is UI\_SELECT\_OPTION.  
7 "Official Notice" is taken for the concept of using different type of PML  
8 object is known and accepted in the art. It would have been obvious to  
9 one having ordinary skill in the art at the time of the invention was  
10 made to include different types of PML objects because by doing so it  
11 would increase the field of use in their systems."  
12

13       Respectfully, the Applicants contest this assertion that general knowledge in  
14 the art of a "HELD\_JOB\_DELETE" PML renders use of the "UI\_SELECT\_OPTION"  
15 PML of claim 14 obvious. Firstly, the Examiner has failed to demonstrate that, at the  
16 time of the present invention, one of ordinary skill in the art would have been aware  
17 that the PML object "UI\_SELECT\_OPTION" even *existed*, let alone that such an  
18 artisan would find it obvious to apply that particular PML object in any way even  
19 remotely similar to that as recited by instant claim 14, as amended. Second of all,  
20 the mere existence of one PML does not render the existence of a second PML  
21 obvious, and moreover, the particular use of a first PML does not render the use of a  
22 second PML obvious for an entirely different purpose! There cannot be anything  
23 obvious about that which is unknown.

24       In accordance with MPEP 2144.03(C), the Applicants respectfully request that  
25 the Examiner provide evidence in support of "Official Notice" as taken with respect to  
demonstrating that one of ordinary skill in the art, at the time of the present

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1 invention, was aware of the PML object UI\_SELECT\_OPTION, and how to apply  
2 that PML object as recited by claim 14, as amended.

3 In summary, the Examiner has failed to show that any of the cited references  
4 provide, teach or suggest the PML object UI\_SELECT\_OPTION, let alone that one  
5 having ordinary skill in the art at the time the invention was made would find it  
6 obvious to apply that PML object in any way even remotely similar to that as recited  
7 by instant claim 14, as amended. In view of the foregoing deficiencies, and in further  
8 view of the requirements as recited by MPEP 706.02(j), the Applicants assert that  
9 the § 103 rejection of claim 14, as amended, is unsupportable and should be  
10 withdrawn.

11 For at least these reasons, the Applicants assert that claim 14, as amended,  
12 is allowable. As claim 15 depends from claim 14, as amended, it is axiomatic that  
13 claim 15 is also allowable.

14  
15 Claim 16

16 The Applicants assert that claim 16, as amended, and claims 17-20 that  
17 depend (directly or indirectly) therefrom, are allowable. In regard to claim 16, as  
18 amended, the claim recites the following features and limitations:

19  
20 An apparatus comprising:

21 a client computer;

22 a peripheral server, connected to the client computer, wherein  
23 the peripheral server receives a first message from the client  
24 computer, the first message containing an address of the client  
25 computer; and

1 a peripheral, connected to the peripheral server, wherein the  
2 peripheral receives the first message from the peripheral server and  
3 notifies the client computer of the peripheral's address, wherein:

4 the first message is formatted as a print job, the print job  
5 including no content resulting in a printed output, and wherein  
6 the print job contains a Peripheral Management Language  
7 (PML) object, and wherein the PML object is  
8 UI SELECT OPTION;

9 the peripheral includes at least one non-printer function;

10 and

11 the client computer is configured to access the at least  
12 one non-printer function of the peripheral using the peripheral's  
13 address and without using the peripheral server.

14 (Emphasis added.)

15  
16 Sorkin fails to teach or suggest a print job [that] contains a Peripheral  
17 Management Language (PML) object, and wherein the PML object is  
18 UI SELECT OPTION, as recited in combination with the other features and  
19 limitations of claim 16, as amended. The 4050 MIB fails to cure the deficiency of  
20 Sorkin. In particular, the 4050 MIB fails to teach or suggest a print job [that] contains  
21 a Peripheral Management Language (PML) object, and wherein the PML object is  
22 UI SELECT OPTION, as recited in combination with the other features and  
23 limitations of claim 16, as amended. The Applicants respectfully reiterate their  
24 request under MPEP 2144.03(C) as stated above for provision of evidence in  
25 support of "Official Notice" as taken by the Examiner in regard to the PML object  
UI\_SELECT\_OPTION. In view of the deficiencies described above, the Applicants  
assert that the § 103 rejection of claim 16, as amended, is unsupportable in view of

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1 MPEP 706.02(j) and should be withdrawn.

2 For at least these reasons, the Applicants assert that claim 16, as amended,  
3 is allowable. As claims 17-20 depend (directly or indirectly) from claim 16, as  
4 amended, it is axiomatic that claims 17-20 are also allowable.

5  
6 Claim 21

7 The Applicants assert that claim 21, as amended, and claims 22, 24 and  
8 26-32 (as respectively amended) that depend therefrom, are allowable. In regard to  
9 claim 21, as amended, the claim recites the following features and limitations:

10  
11 A method for communication between networked devices, the  
12 method comprising:

13 sending a first message from a client to a peripheral server by  
14 way of a network, the first message including a network address of the  
15 client, and wherein the first message is formatted as a print job  
16 containing a Peripheral Management Language (PML) object, and  
17 wherein the PML object UI SELECT OPTION;

18 sending the first message from the peripheral server to a  
19 multifunction peripheral by way of the network;

20 sending a second message from the multifunction peripheral to  
21 the client by way of the network, the second message including a  
22 network address of the multifunction peripheral; and

23 accessing a non-printer function of the multifunction peripheral  
24 by way of the network using the client and the network address of the  
25 multifunction peripheral and without using the peripheral server.

(Emphasis added.)

1 Sorkin fails to teach or suggest a first message is formatted as a print job  
2 containing a Peripheral Management Language (PML) object, and wherein the PML  
3 object UI SELECT OPTION, as recited in combination with the other features and  
4 limitations of claim 21, as amended. Again, Sorkin is directed to establishing  
5 communication by way of SNMP traps. This is not the same as the invention as  
6 recited by claim 21, as amended.

7 Bacher fails to cure the deficiencies of Sorkin. Specifically, Bacher fails to  
8 teach or suggest a first message is formatted as a print job containing a Peripheral  
9 Management Language (PML) object, and wherein the PML object  
10 UI SELECT OPTION, as recited in combination with the other features and  
11 limitations of claim 21, as amended.

12 Rather, Bacher is directed to a multifunction terminal wherein an arrangement  
13 of feeding stations 12, 14, intermediate storing trays 62, 63, and feeding members  
14 77 are cooperatively disposed with respect to a printer 51, a data reader 55, etc.,  
15 along a feeding path 18 (Abstract; Fig. 1 of Bacher). In short, Bacher is directed to a  
16 particular arrangement of sheet media handling parts and sub-systems within a  
17 multifunctional device. Bacher provides no teaching or suggestion whatsoever in  
18 regard to sending the first message from the peripheral server to a multifunction  
19 peripheral by way of the network, sending a second message from the multifunction  
20 peripheral to the client by way of the network, the second message including a  
21 network address of the multifunction peripheral, and then accessing a non-printer  
22 function of the multifunction peripheral by way of the network using the client and the  
23 network address of the multifunction peripheral and without using the peripheral  
24 server, as recited in combination with the other features and limitations of claim 21,  
25 as amended. Bacher does not teach or suggest use of any PML object, in any way.

There is no way to combine elements selected from Sorkin, and then to  
somehow combine those elements with other elements selected from Bacher, in

1 order to arrive at the invention as recited by claim 21, as amended, as no possible  
2 combination of Sorkin with Bacher teaches or suggests all of the necessary  
3 limitations. This deficiency renders the § 103 rejection of claim 21, as amended,  
4 unsupportable in view of the requirements of MPEP 706.02(j). The fact is, none of  
5 the references cited thus far in the case record provide, teach or suggest the PML  
6 object UI\_SELECT\_OPTION of claim 21.

7 For at least these reasons, the Applicants assert that claim 21, as amended,  
8 is allowable. As claims 22, 24 and 26-32 (as respectively amended) depend from  
9 claim 21, as amended, it is axiomatic that claims 22, 24 and 26-32, as respectively  
10 amended, are also allowable.

#### 11 12 Rejection of Claims under Non-Statutory Double Patenting

13 Claim 14 is rejected under the judicially created doctrine of obviousness-type  
14 double patenting as being unpatentable over claims 1 and 7 of U.S. Patent No.  
15 6,559,965 ("Simpson at al.") (pages 2-3 of Office Action).

16 In light of the fact that the claim 14 has been amended, the Applicants  
17 respectfully request reconsideration of the obviousness-type double patenting of this  
18 claim in light of the amendments.

#### 19 20 Status of Instant Application

21 The Examiner's statement that the instant application is currently pending as  
22 a result of a request for a Continued Prosecution Application (CPA), as filed on  
23 12/27/04 in accordance with 37 CFR 1.53(d), is not correct (page 2 of Office Action).

24 In fact, the instant application is currently pending as a result of a Request for  
25 Continued Examination in accordance with 37 CFR 1.114, as deposited with the  
United States Postal Service as First Class mail on December 20, 2004. The  
Examiner is respectfully referred to that submission to the Office.

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The Examiner is respectfully requested to contact the below-signed representative if the Examiner believes this will facilitate prosecution toward allowance of the claims.

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